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REMARKS

The above-amendments and following remarks are responsive to the Examiner's official communication of August 9, 2006. As will be discussed below, the pending claims are patentable by virtue of the fact that the cited prior art fails to teach or suggest at least one important limitation recited by the claims. To anticipate a claim under 35 U.S.C. § 102, a single source must contain all of the elements of the claim. *Lewmar Marine Inc. v. Bariant, Inc.*, 827 F.2d 744, 747, 3 U.S.P.Q. 2d 1766, 1768 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 1007 (1988). In order to make out or sustain a rejection for obviousness, all of the claim limitations must be taught or suggested in the prior art. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The claims have been amended to further define the invention as specific to the art of capturing specially designed ferrules, which are associated with suture, with specially designed needles. Reference is made to the Specification at page 16, lines 19-29. Such description details how a configuration covered by amended claim 1 permits a ferrule to be held better onto the tip when captured by the needle. The groove behind the needle tip permits a reduced amount of tip surface area to frictionally engage the ferrule. This reduced area more easily deforms a portion of the ferrule between the front and rear of the ferrule, providing a good hold by the tip with reduced force requirements.

With regard to the Examiner's rejections of the claims under 35 U.S.C. 103(a) over the Applicant's '183 and '666 patents, it is noted that this needle tip geometry is simply not taught. They both teach friction fit, but not the geometry claimed herein. The needle tips of the '666 are straight and uniform until the sharpened ends. The needles of the '183 patent are also straight and uniform until the tips. The '183 patent does taper *distally* twice (once to permit the ferrule outer diameter to match the needle outer diameter, and once again to provide the sharpened tip for piercing tissue), but *nowhere includes a groove or proximal*

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*taper* near the tip. In order to make out a *prima facie* case of obviousness, all elements must be found in the prior art.

Further, there is no suggestion within either Sauer patents to modify them to include a groove or proximal taper. The Federal Circuit states, “[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” *In re Fritch*, 972 F.2d 1260, 1266, n.4, 23 USPQ2d 1780, 1783-84, n.14 (Fed. Cir. 1992) (citing *In re Gordon*, 773 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed Cir. 1984)). “Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor.” *Paramount Ordinance Mfg. v. SGS Importers Int'l.*, 73 F.3d 1087, 37 USPQ2d 1239 (Fed. Cir. 1995) (citing *W. L. Gore & Associates v. Garlock, Inc.*, 721 F.2d at 1551, 1553, 220 USPQ at 311, 312-13 (Fed. Cir. 1983)).

Reconsideration and allowance of the claims is respectfully requested.

If there are any charges with respect to the presently submitted response or otherwise, please charge them to deposit account 06-1130, maintained by the Applicant's attorneys. A general authorization to charge fees to deposit account 06-1130 is given, including any required extension fees.

Respectfully Submitted,

CANTOR COLBURN, LLP  
Applicant's Attorneys

By: H. M. Bedingfield  
H. M. Bedingfield  
Registration No. 44,530

Dated: February 9, 2007  
Address: 55 Griffin Road South, Bloomfield, CT 06002  
Telephone: (860) 286-2929